Supreme Court, U.S.
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No. 01-269

IN THE

Supreme Court of the United States

CREO PRODUCTS INC.,

Petitioner,

v.

DAINIPPON SCREEN MFG. CO., LTD., D.S. NORTH AMERICA HOLDINGS, INC., and DS AMERICA, INC.,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

REPLY BRIEF

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Petitioner Creo Products Inc. hereby responds to Respondent's Opposition as follows:

The Federal Circuit clearly relied on its decision in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabashuki Co., Ltd.*, 234 F.3d 558 (Fed. Cir. 2000) to affirm the district court below. The Federal Circuit's own decision states, "We agree with Dainippon that our decisions in *Sextant Avionique, S.A. v. Analog Devices, Inc.*, 172 F.3d 817 . . . (Fed. Cir. 1999), and *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabashuki Co.*, 234 F.3d 558 . . . (Fed. Cir. 2000), preclude application of the doctrine of equivalents under the facts of this case. . . ." (App. 4a). Not only did the Federal Circuit expressly rely on *Festo* below, this single sentence is, in fact, the *only* reason given by the Federal Circuit for affirming the district court's summary dismissal of Creo's patent infringement claim. Respondent's claim that *Festo* played no role in the ultimate disposition of this case is untrue.

As in *Festo*, the issue here is whether the decisions of the Federal Circuit and district court below are consistent with this Court's precedent in *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17 (1997). The issue here, namely whether the "presumption" expressed in *Warner-Jenkinson* should apply when an "unexplained" amendment originates with the Patent Examiner as opposed to the patent applicant, arises directly from this Court's holding in *Warner-Jenkinson*. In *Warner-Jenkinson*, this Court stated, "Where no explanation [for an amendment] is established . . . the court should presume that the *patent applicant* had a substantial reason related to patentability for including the limiting element added by amendment." *Id.* at 33. (Emphasis supplied.)

This language from *Warner-Jenkinson* strongly suggests that the presumption created by this Court is intended to apply when a *patent applicant* makes an amendment without explaining his reasons for doing so. This language, which focuses specifically

on the actions of a patent applicant, further suggests that the presumption does not arise when someone other than the patent applicant (i.e., the Patent Examiner) makes an amendment. The difference whether the Patent Examiner or patent applicant proposes an amendment is not immaterial.

Patent applicants and Patent Examiners have different interests and incentives. Unlike a patent applicant who might be tempted to amend a claim without explanation in an effort to avoid prior art without creating an estoppel, the Examiner, who represents the public's interest in deciding whether to grant patent rights, has no such incentive. On the contrary, the Examiner is interested in seeing that only valid patents of proper scope are issued. The Examiner, therefor, has no reason whatsoever to propose amendments for anything other than completely legitimate, proper purposes. The purpose behind the *Warner-Jenkinson* presumption, namely to provide an incentive for *patent applicants* to explain the reasons for their amendments, does not exist in the case of amendments proposed by the Examiner rather than patent applicant.

Contrary to Respondent's claims, this argument was indeed presented below.[1] Creo never abandoned its claim of patent infringement. On the contrary, Creo properly recognized that the Federal Circuit's just then issued decision in *Festo* expressly eliminated the "flexible bar" on which Creo relied and precluded an outcome favorable to Creo. Rather than submit a hopeless and intellectually dishonest argument that *Festo* somehow did not control, Creo elected instead to preserve its rights against the possibility that this Court might reject the *en banc* holding of the Federal Circuit in *Festo*. Respondent's claim that Creo abandoned its patent claims is untrue.

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1. Creo's arguments regarding the doctrine of equivalents and the significance of amendments made by the Examiner as opposed to patent applicant made up more than two-thirds of Creo's opening brief to the Federal Circuit as well as a significant part of Creo's oral argument before that court.

Finally, Respondent's claim that this case is a "poor vehicle" for addressing considerations of fairness is without basis. Respondent's claim that these issues do not appear "in the record" is untrue. The prosecution history of the Gelbart patent clearly shows that the Examiner proposed the claim amendment at issue. The deposition testimony of Mr. Gelbart clearly addresses the circumstances surrounding his application for his patent.[2] The arguments against application of the *Warner-Jenkinson* presumption under the facts of this case made up the bulk of Creo's opening brief to the Federal Circuit. Despite Respondent's arguments and rhetoric, the fact remains that Respondent does not, and cannot, challenge a single one of the material facts presented in Creo's Petition for Certiorari.

The instant case remains a dramatic example of the injustices that result from the mechanical, bright line test adopted by a panel of the Federal Circuit in *Sextant Avionique, S.A. v. Analog Devices, Inc.*, and applied across the board by the *en banc* decision in *Festo*. The unique issues raised here, including whether all access to the doctrine of equivalents should be lost when Examiner's Amendments are made to a patent application, are important far beyond the confines of this case. That issue is not directly raised in *Festo*, but remains of extreme importance to the owners of the hundreds of thousands of unexpired patents having examiner's amendments in their file histories.

The instant case was, in fact, disposed of on the basis of *Festo*. To the extent this Court overrules or otherwise modifies the holding in *Festo*, this case should be remanded for proceedings consistent therewith. Given that this case raises issues that are closely related to those in *Festo*, but nevertheless unique, certiorari should be granted so that this Court can consider all

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2. To the extent any relevant facts are not "of record," this is because the district court dismissed Creo's claim on summary judgment. Obviously, missing facts, if any, can be supplied in the event of a remand.

related issues in its forthcoming review. At the very least, a decision on this Petition for Certiorari should be held in abeyance until *Festo* is decided so that the Court can consider then whether the modifications to *Festo* warrant a remand here.

CONCLUSION

For the foregoing reasons, the Petition should be granted.

Respectfully submitted,

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